### Remarks

### **Amendment of Claim 3**

The Applicants respectfully request that the amendment to claim 3 be entered in the application before issuance. The proposed amendment to claim 3 corrects an antecedent basis inconsistency in the claim and is unrelated to patentability. Further, the amendment is not believed to require a substantial amount of additional work on the part of the Office.

# Request for Consideration of Information Disclosure Statement Submitted on December 30, 2004

The Applicants additionally request that the Information Disclosure Statement (IDS) filed on December 30, 2004, be considered by the Examiner. Attached Exhibit A is a copy of the IDS filed on December 30, 2004, and includes a properly executed certificate of mailing under 37 C.F.R. § 1.8. Attached Exhibit B is a copy of the Notice of Allowance, which was mailed on January 18, 2005. Because the IDS was filed before the mailing date of the Notice of Allowance, the IDS should have been considered in the regular course of prosecution pursuant to 37 C.F.R. § 1.97(c).

# Request for Consideration of Information Disclosure Statement Submitted Pursuant to 37 C.F.R. § 1.97(d)

The applicants are additionally enclosing an Information Disclosure Statement (IDS) under 37 C.F.R. § 1.97(d). Because this IDS is being filed prior to the payment of the issue fee and is accompanied by the proper statement and fee, it should be considered by the Office pursuant to 37 C.F.R. § 1.97(d).

### **Conclusion**

With entry of this amendment and consideration of the above-mentioned IDSs, it is believed that this application is in condition for allowance and issuance. Should the Examiner have any questions concerning this Amendment, she is invited to call the undersigned attorney.

If any additional fee is required in connection with the filing of this Amendment, please charge such fee to Deposit Account 02-4550.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

By

David P. Petersen

Registration No. 28,106

One World Trade Center, Suite 1600 121 S.W. Salmon Street Portland, Oregon 97204

Telephone: (503) 595-5300 Facsimile: (503) 228-9446



### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Rajski et al.

**Application No.** 09/620,021

Filed: July 20, 2000

Confirmation No. 3823

For: CONTINUOUS APPLICATION AND

**DECOMPRESSION OF TEST PATTERNS** 

TO A CIRCUIT-UNDER-TEST

Examiner: Phung M. Chung

Art Unit: 2133

Attorney Reference No. 1011-54375-01

COMMISSIONER FOR PATENTS P.O. BOX 1450 ALEXANDRIA, VA 22313-1450

#### **CERTIFICATE OF MAILING**

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450 on the date shown below.

Attorney for Applicant

Date Mailed

## INFORMATION DISCLOSURE STATEMENT PURSUANT TO 37 C.F.R. § 1.97(c)

Listed on the accompanying form PTO-1449 and enclosed herewith are several English-language and/or non-English-language documents. Applicants respectfully request that these documents be listed as references cited on the issued patent. This Information Disclosure Statement ("IDS") is being mailed before Applicants received a final action, a notice of allowance, or an action that otherwise closes prosecution in the referenced application.

Copies of United States patents and United States published patent applications do not have to be provided to the Patent Office (37 C.F.R. 1.98(a)(2)(ii)). Copies of unpublished U.S. applications do not have to be provided, as long as the application is available on PAIR, as this requirement of 37 C.F.R. § 1.98(a)(2)(iii) has been waived by the United States Patent and Trademark Office pursuant to the Official Gazette Notice on October 19, 2004 (1287 OG 163). Applicants will provide copies of such patents or applications upon request.

Further, several foreign language documents are cited in the accompanying form PTO-1449. Specifically, Japanese Patent Publication Nos. 4-236378, 11-153655, and 9-130378 are cited. The abstract of Japanese Patent Publication No. 4-236378 recites that "a method and apparatus for testing a VLSI device 10 are described. The invention uses the idea that the internal logic of the VLSI device can be broken down into linked sections or cones. . . . The apparatus incorporates a Linear Feedback Shift Register (300) which is fed by a seed to produce a bit pattern to test the VLSI device (10). The seed is so chosen that the LFSR generates the required bit values on the input latches 30 which are required for the particular test being carried out and pseudo-random values for all other latches." The abstract of Japanese Patent Publication No. 11-153655 recites that the problem to be solved by the disclosed invention is "to provide an IC chip inspection device which inspects IC chips by using test data composed of many test vectors." The disclosed invention is "[a]n IC chip inspection device . . . with a pin memory, a sequencer memory, and a driving section. The pin memory stores many test blocks and each test block is the combination of at least one test vector among text [sic] vectors and repeated at least one time in test data. The sequencer memory stores the information on the designating order of the test blocks for restoring the test data." Japanese Patent Publication No. 9-130378 is understood to disclose a process for pledging data for a secure data-exchange protocol that has nothing to do with testing integrated circuits. The disclosed method, however, mentions the use of random number generators as part of the process.

Submitted herewith is a check for \$180.00 as required by 37 C.F.R. § 1.17(p) for filing this IDS in compliance with 1.97(c).



DPP/PMB:iar 12/29/04 1011-54375-01 339935

Please charge any additional fees which may be required in connection with filing this IDS, or credit any overpayment, to Deposit Account No. 02-4550. A duplicate copy of this sheet is enclosed.

The filing of this IDS shall not be construed to be an admission that the information cited in the statement is, or is considered to be, prior art or otherwise material to patentability as defined in 37 C.F.R. §1.56.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

By

Patrick M. Bible

Registration No. 44,423

One World Trade Center, Suite 1600 121 S.W. Salmon Street Portland, Oregon 97204 Telephone: (503) 226-7391

Facsimile: (503) 228-9446

cc:

Client

Docketing



# FEB 2 2 2005 8

### INFORMATION DISCLOSURE STATEMENT BY APPLICANT

1011-54375-01
09/620,021
July 20, 2000
Rajski
2133
Phung M. Chung

### U.S. PATENT DOCUMENTS

Copies of U.S. Patent documents do not need to be provided, unless requested by the Patent and Trademark Office. For patents, provide the patent number and the issue date. For published U.S. applications, provide the publication number and the publication date. For unpublished pending patent applications, provide the application number and the filing date.

Examiner's Initials*	Cite No. (optional)	Number	Publication Date	Name of Applicant or Patentee
		4,536,881	8.20.1985	Kasuya
		5,870,476	2.9.1999	Fischer
		5,872,793	2.16.1999	Attaway et al.
		5,883,906	3.16.1999	Turnquist et al.
		6,122,761	9.19.2000	Park
		6,708,192	3.16.2004	Rajski et al.
	<del> </del>	6,829,740	12.7.2004	Rajski et al.

### FOREIGN PATENT DOCUMENTS

Examiner's Initials*	Cite No. (optional)	Country	Number	Publication Date	Name of Applicant or Patentee
·		Europe	EP 0372226	6.13.1990	Bardell
<del></del>		Europe	EP 0438322	7.24.1991	Murase
<u> </u>		Europe	EP 0481097	4.22.1992	Diebold et al.
		Japan	JP 4-236378	8.25.1992	Diebold et al.
		Japan	JP 9-130378	5.16.1997	Fischer
		Europe	EP 0887930	12.30.1998	Tarrab et al.
<u> </u>		Japan	JP 11-153655	6.8.1999	Park

EXAMINER SIGNATURE:

DATE CONSIDERED:

\* Examiner: Initial if reference considered, whether or not in conformance with MPEP 609. Draw in conformance and not considered. Include copy of this form with next communication to appli





### INFORMATION DISCLOSURE STATEMENT BY APPLICANT

/	
Attorney Docket Number	1011-54375-01
Application Number	09/620,021
Filing Date	July 20, 2000
First Named Inventor	Rajski
Art Unit	2133
Examiner Name	Phung M. Chung

	Examinor reality
Cite No. (optional)	OTHER DOCUMENTS
	Bassett et al., "Low-Cost Testing of High-Density Logic Components," IEEE Design &
<u> </u>	Test of Computers, pp. 15-28 (April 1990).
	Fagot et al., "On Calculating Efficient LFSR Seeds for Built-In Self Test," IEEE, pp. 7-14
	(1999).
<del>                                     </del>	Hellebrand et al., "Generation of Vector Patterns Through Reseeding of Multiple-
ļ	Polynomial Linear Feedback Shift Registers," IEEE International Test Conference, pp.
,	120-129 (1992).
<del> </del>	Wang, "BIST Using Pseudorandom Test Vectors and Signature Analysis," IEEE Custom
	Integrated Circuits Conference, pp. 1611-1618 (1998).
	<b>4.00</b>

EXAMINER SIGNATURE:

DATE CONSIDERED:

\* Examiner: Initial if reference considered, whether or not in conformance with MPEP 609. Draw in conformance and not considered. Include copy of this form with next communication to applic



### United States Patent and Trademark Office

Mentor G/DPP

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS

P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

FEB 2 2 2005 2

### NOTICE OF ALLOWANCE AND FEE(S) DUE

01/18/2005

KLARQUIST SPARKMAN CAMPBELL LEIGH & WHINSTON, LLP One World Trade Center, Suite 1600 121 S.W. Salmon Street Portland, OR 97204-2988 4/18/05 4/1

EXAMINER

CHUNG, PHUNG M

ART UNIT PAPER NUMBER

2133

DATE MAILED: 01/18/2005

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/620,021	07/20/2000	Janusz Rajski	1011-54375	3823	

TITLE OF INVENTION: CONTINUOUS APPLICATION AND DECOMPRESSION OF TEST PATTERNS TO A CIRCUIT-UNDER-TEST

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1400	\$0	\$1400	04/18/2005

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATEN <u>PROSECUTION ON THE MERITS IS CLOSED</u>. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHT THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPO PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM TH MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THE STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOV REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (O AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WIL BE REGARDED AS ABANDONED.

### HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is n claiming SMALL ENTITY status, check box 5a on Part B - Fee Transmittal and pay the PUBLICATION FEE (if required) and 1 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) w your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.



#### PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: Mail

Mail Stop ISSUE FEE Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450

or Fax

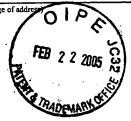
(703) 746-4000

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed wh appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" maintenance fee notifications.

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01/18/2005

KLARQUIST SPARKMAN CAMPBELL LEIGH & WHINSTON, LLP One World Trade Center, Suite 1600 121 S.W. Salmon Street Portland, OR 97204-2988



Note: A certificate of mailing can only be used for domestic mailings of Fee(s) Transmittal. This certificate cannot be used for any other accompany papers. Each additional paper, such as an assignment or formal drawing, m have its own certificate of mailing or transmission.

Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the Un States Postal Service with sufficient postage for first class mail in an envel addressed to the Mail Stop ISSUE FEE address above, or being facsim transmitted to the USPTO (703) 746-4000, on the date indicated below

ransmitted to the USPIO (703) 746-2	ooo, on the date indicated below.
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/620,021	07/20/2000	Janusz Rajski	1011-54375	3823

TITLE OF INVENTION: CONTINUOUS APPLICATION AND DECOMPRESSION OF TEST PATTERNS TO A CIRCUIT-UNDER-TEST

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1400	\$0	\$1400	04/18/2005
EXAI	MINER	ART UNIT	CLASS-SUBCLASS		•
CHUNG,	PHUNG M	2133	714-733000	_	
CR 1.363).  Change of correspond Address form PTO/SB/  Thee Address' indiction PTO/SB/47; Rev 03-02 Number is required.  ASSIGNEE NAME AN PLEASE NOTE: Unles recordation as set forth (A) NAME OF ASSIGNATION ASSI	ation (or "Fee Address" Indicate or more recent) attached. Use D RESIDENCE DATA TO BE as an assignee is identified belin 37 CFR 3.11. Completion of NEE	orrespondence (or	will appear on the patent. If an assistantiate for filing an assignment.  ESIDENCE: (CITY and STATE OR C	s a member a 2s a member a 1s a member a 2s a member a 3s a member a 3s a member a 3s a member a 3s a member a 2s a member a 3s a member a 2s a member a 3s a member a 2s a member a 2s a member a 3s a member a 2s a member a 2s a member a 2s a member a 3s a member a 2s a member a 2s a member a 2s a member a 3s a member a 2s a member a 3s a member	
ease check the appropria . The following fee(s) ar	te assignee category or categori e enclosed:		iyment of Fee(s):	Corporation of other private gr	oup entity - Coveri
Issue Fee		_	A check in the amount of the fee(s) is	enclosed.	
	small entity discount permitted	i) 🗀	Payment by credit card. Form PTO-20	038 is attached.	
_ `	of Copies		The Director is hereby authorized by posit Account Number		credit any overpayme copy of this form).
	s (from status indicated above)				7
a. Applicant claims	SMALL ENTITY status. See 3	7 CFR 1.27.	b. Applicant is no longer claiming SM	IALL ENTITY status. See 37 C	CFR 1.27(g)(2).
ha Director of the LISPT	) is requested to apply the Issue	Fee and Publication	Fee (if any) or to re-apply any previo	usly paid issue fee to the applic	ation identified above.
OTE: The Issue Fee and terest as shown by the re	Publication Fee (if required) w cords of the United States Pater	ill not be accepted fro nt and Trademark Off	Fee (if any) or to re-apply any previous anyone other than the applicant; a racice.	egistered attorney or agent, or	the assignee or other p

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to proc an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of the USPTO to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of the USPTO to the USPTO to proceed the complete application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of the use of the complete application for reducing the use of the USPTO to proceed the use of the use

Typed or printed name

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid ON

Registration No.



### UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450

APPLICATION NO. FILING DATE FIRST NAMED INVENTOR ATTORNEY DOCKET NO. CONFIRMATION NO. 09/620,021 07/20/2000 Janusz Rajski 1011-54375 3823

7590

01/18/2005

KLARQUIST SPARKMAN CAMPBELL LEIGH & WHINSTON, LLP One World Trade Center, Suite 1600 121 S.W. Salmon Street Portland, OR 97204-2988



EXAMINER
CHUNG, PHUNG M

ART UNIT PAPER NUMBER
2133

**DATE MAILED: 01/18/2005** 

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)

(application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 246 day(s). If the issue fee is paid on the date that is three months after t mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a ha months) after the mailing date of this notice, the Patent Term Adjustment will be 246 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date th determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retriev (PAIR) WEB site (http://pair.uspto.gov).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office Patent Legal Administration at (571) 272-7702. Questions relating to issue and publication fee payments should directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.

